

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Anja BAUER et al.

**Confirmation No. 3148**

Group Art Unit: 1617

Serial No. : 10/812,469

Examiner: Jean-Louis, Samira

Filed : March 29, 2004

For : COSMETIC OR DERMATOLOGICAL STICK

**REPLY BRIEF UNDER 37 C.F.R. § 41.41(a)(1)**

Commissioner for Patents  
U.S. Patent and Trademark Office  
Customer Service Window, Mail Stop Appeal Brief - Patents  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

This Reply Brief is in response to the Examiner's Answer mailed March 24, 2009, the period for reply extending until May 26, 2009 (May 24, 2009 being a Sunday and May 25, 2009 being a Federal Holiday).

In the Examiner's Answer all appealed grounds of rejection are maintained.

Appellants note that the Examiner's Answer does not sufficiently address several of Appellants' arguments as to why the rejections are without merit. These deficiencies have prompted the present Reply Brief.

Appellants also note that this Reply Brief is being filed under 37 C.F.R. § 41.41(a)(1) and is directed to the arguments presented in the Examiner's Answer, and therefore must be entered unless the final rejection is withdrawn in response to the instant Reply Brief.

In order to avoid repetition, the following response to the Examiner's arguments in the Examiner's Answer will be limited to issues which are important enough to warrant a further

comment in Appellants' opinion. Accordingly, Appellants' silence with respect to any allegations set forth in the Examiner's Answer which are not specifically addressed below should by no means be construed as Appellants' admission that these allegations are of any merit.

## REPLY

1. Appellants note that the Examiner maintains the position that SCHREIBER (U.S. Patent No. 6,613,338) "teaches addition of lactic acid and glycine [allegedly well known as moisturizers] to the composition in an amount of 0.001 to 30 %". Appellants also note that the passages of SCHREIBER on which this allegation is based are col. 13, lines 21 to 62 and col. 14, lines 1-5 which are reproduced below (emphasis added):

The antioxidants are particularly advantageously chosen from the group consisting of amino acids (for example glycine, histidine, tyrosine, tryptophan) and derivatives thereof, imidazoles (e.g. urocanic acid) and derivatives thereof, peptides such as D,L-carnosine, D-carnosine, L-carnosine and derivatives thereof (e.g. anserine), carotenoids, carotenes (e.g.  $\alpha$ -carotene,  $\beta$ -carotene, lycopene) and derivatives thereof, lipoic acid and derivatives thereof (e.g. dihydrolipoic acid), aurothioglucose, propylthiouracil and other thiols (e.g. thioglycerol, thiosorbitol, thioglycolic acid, thioredoxin, glutathione, cysteine, cystine, cystamine and the glycosyl, N-acetyl, methyl, ethyl, propyl, amyl, butyl and lauryl, palmitoyl, oleyl,  $\gamma$ -linoleyl, cholesteryl and glyceryl esters thereof) and salts thereof, dilauryl thiodipropionate, distearyl thiodipropionate, thiodipropionic acid and derivatives thereof (esters, ethers, peptides, lipids, nucleotides, nucleosides and salts) and sulfoximine compounds (e.g. buthionine sulfoximines, homocysteine sulfoximine, buthionine sulphones, penta-, hexa-, heptathionine sulfoximine) in very small tolerated doses (e.g. pmol to  $\mu$ mol/kg), also (metal) chelating agents (e.g.  $\alpha$ -hydroxy fatty acids, palmitic acid, phytic acid, lactoferrin),  $\alpha$ -hydroxy acids (e.g. citric acid, lactic acid, malic acid), humic acid, bile acid, bile extracts, bilirubin, biliverdin, EDTA, EGTA and derivatives thereof, unsaturated fatty acids and derivatives thereof (e.g.  $\gamma$ -linolenic acid, linoleic acid, oleic acid), folic acid and derivatives thereof, ubiquinone and ubiquinol and derivatives thereof, vitamin C and derivatives (e.g. ascorbyl palmitates, Mg ascorbyl phosphates, ascorbyl acetates), isbascorbic acid and derivatives thereof, tocopherols and derivatives (e.g. vitamin E acetate), vitamin A and derivatives (vitamin A palmitate) and coniferylbenzoate of

benzoin, rutinic acid and derivatives thereof, ferulic acid and derivatives thereof, butylated hydroxytoluene, butylated hydroxyanisole, nordihydroguaiac resin acid, nordihydroguaiaretic acid, trihydroxybutyrophenone, uric acid and derivatives thereof, mannose and derivatives thereof, zinc and derivatives thereof (e.g. ZnO, ZnSO<sub>4</sub>), selenium and derivatives thereof (e.g. selenium methionine), stilbenes and derivatives thereof (e.g. stilbene oxide, trans-stilbene oxide) and the derivatives (salts, esters, ethers, sugars, nucleotides, nucleosides, peptides and lipids) of said active ingredients which are suitable according to the invention.

[...]

The amount of antioxidants (one or more compounds) in the preparations is preferably from 0.001 to 30% by weight, particularly preferably 0.05-20% by weight, in particular 1-10% by weight, based on the total weight of the preparation.

Accordingly, while SCHREIBER discloses that one or more antioxidants may optionally be present in the compositions disclosed therein and that the one or more antioxidants may be present in a total concentration of from 0.001% to 30% by weight, it must be taken into account that glycine and lactic acid are buried in a laundry list of more than hundred exemplary antioxidants of most diverse types. Thus, even if one were to assume, *arguendo*, that in view of the disclosure of SCHREIBER one of ordinary skill in the art would be motivated to include one or more antioxidants in the compositions disclosed therein, there clearly is no apparent reason to pick specifically glycine and/or lactic acid, i.e., compounds which are not typically and frequently employed as antioxidants (or moisturizers) in cosmetic compositions, and employ significant amounts thereof (i.e., a total of at least 3 % by weight) in the compositions of SCHREIBER.

It also is pointed out again that not a single one of the altogether 27 exemplified compositions of SCHREIBER contains any antioxidant, let alone any substance from the laundry list of antioxidants disclosed by SCHREIBER. This is a clear indication for one of ordinary skill in the art that antioxidants are not important and do not provide any

particular benefit for the compositions of SCHREIBER. In view thereof, Appellants are still unable to see that the teaching of SCHREIBER provides an apparent reason for one of ordinary skill in the art to incorporate significant amounts of any antioxidant, let alone of glycine and/or lactic acid, into the compositions of SCHREIBER.

It further is pointed out again that one of ordinary skill in the art will readily recognize that the broad concentration range of 0.001% to 30% by weight for the one or more antioxidants that are disclosed by SCHREIBER does not apply to each and every individual antioxidant (or each and every combination of antioxidants) from the laundry list provided by SCHREIBER. For example, some of the antioxidants mentioned by SCHREIBER such as, e.g., selenium and derivatives thereof would apparently be toxic if they were employed in amounts which are not close to the lower value of the concentration range of 0.001% to 30% by weight. In fact, the above passage of SCHREIBER even mentions that some of the listed antioxidants are to be employed “in very small tolerated doses (pmol to  $\mu$ mol/kg)”. Also, there probably is not a single antioxidant that one of ordinary skill in the art would employ in a concentration of 0.001% by weight in one case and in a concentration of 30% by weight in another case.

Accordingly, one of ordinary skill in the art will understand that each of the antioxidants which are disclosed by SCHREIBER is to be used in the concentration in which it is conventionally employed (in cosmetic compositions of the type taught by SCHREIBER), provided that this concentration is preferably within the ranges set forth therein.

In this regard, it is stressed again that the Examiner has not cited a single document which discloses any cosmetic composition, let alone a cosmetic composition of

the type disclosed by SCHREIBER, which contains a significant amount of lactic acid and/or glycine and in particular, contains lactic acid and/or glycine in a (total) concentration of at least 3 % by weight (if one were to assume that 2 % by weight of glycerol are present as well), regardless of the stated intended function of lactic acid and/or glycine in a corresponding composition. Accordingly, even if one were to assume, *arguendo*, that one of ordinary skill in the art would be motivated to incorporate one or more of glycerol, glycine and lactic acid into a composition according to SCHREIBER, the Examiner has failed to establish that this would cause a skilled person to employ glycerol, glycine and lactic acid in a total concentration of at least 5 % by weight.

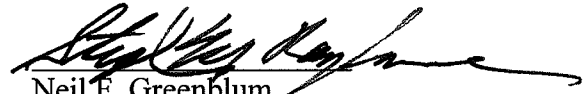
2. Regarding the combination of the teachings of SCHREIBER and PESCATORE (U.S. Patent No. 5,753,212) Appellants note that the Examiner apparently is of the opinion that SCHREIBER and PESCATORE both disclose cosmetic products in stick form. Although this is correct, it must not be overlooked that the cosmetic products in stick form of SCHREIBER are lipsticks, antiacne sticks, sunscreen sticks and eyeshadow sticks (see, e.g., abstract of SCHREIBER), while according to e.g., the abstract of PESCATORE the cosmetic products in stick form mentioned therein are antiperspirant and deodorant sticks (of unknown composition). In other words, except for being in stick form, the products of SCHREIBER and PESCATORE have absolutely nothing in common. It is not even possible to compare the chemical compositions of these products because PESCATORE provides no information whatsoever in this regard. Appellants submit that for this reason alone, there is no motivation whatsoever for one of ordinary skill in the art to combine the teachings of SCHREIBER and PESCATORE.

## CONCLUSION

The request to reverse the rejection of claims 18-29 and 32-36 and to return the application to the Examining Group for prompt allowance is respectfully maintained.

Although no fee is believed to be required for entry of this Reply Brief, the Patent and Trademark Office is hereby authorized to charge any fee that is deemed to be necessary to Deposit Account No. 19-0089.

Respectfully submitted,  
Anja BAUER et al.



Neil F. Greenblum  
Reg. No. 28,394

May 20, 2009  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191